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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,076	06/06/2001	Ruoping Chen	AREN-0239	6379

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EXAMINER

MERTZ, PREMA MARIA

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 09/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/875,076

Applicant(s)

Chen et al.

Examiner

Preme Mertz

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 6, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-76 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-13 and 15-76 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s).        |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1443) Paper No(s) | 6) <input type="checkbox"/> Other:  |

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### DETAILED ACTION

Claim 14 has been canceled in Paper No.4, 6/6/01.

#### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 3-4, drawn to a cDNA encoding a polypeptide of SEQ ID NO:2, a vector, a host cell, classified in Class 536, subclass 23.1.
  - II. Claim 2, drawn to a polypeptide of SEQ ID NO:2, classified in Class 530, subclass 350.
  - III. Claims 5, 7-8, drawn to a cDNA encoding a polypeptide of SEQ ID NO:4, classified in Class 536, subclass 23.1.
  - IV. Claim 6, drawn to a polypeptide of SEQ ID NO:4, classified in Class 530, subclass 350.
  - V. Claims 9, 11-12, drawn to a cDNA encoding a polypeptide of SEQ ID NO:6, classified in Class 536, subclass 23.1.
  - VI. Claim 10, drawn to a polypeptide of SEQ ID NO:6, classified in Class 530, subclass 350.
  - VII. Claims 13, 15-16, drawn to a cDNA encoding a polypeptide of SEQ ID NO:8, classified in Class 536, subclass 23.1.
  - VIII. Claims 17, 19-20, drawn to a cDNA encoding a polypeptide of SEQ ID NO:10, classified in Class 536, subclass 23.1.

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IX. Claim 18, drawn to a polypeptide of SEQ ID NO:8, classified in Class 530, subclass 350.

X. Claims 21, 23-24, drawn to a cDNA encoding a polypeptide of SEQ ID NO:12, classified in Class 536, subclass 23.1.

XI. Claim 22, drawn to a polypeptide of SEQ ID NO:12, classified in Class 530, subclass 350.

XII. Claims 25, 27-28, drawn to a cDNA encoding a polypeptide of SEQ ID NO:14, classified in Class 536, subclass 23.1.

XIII. Claim 26, drawn to a polypeptide of SEQ ID NO:14, classified in Class 530, subclass 350.

XIV. Claims 29, 31-32, drawn to a cDNA encoding a polypeptide of SEQ ID NO:16, classified in Class 536, subclass 23.1.

XV. Claim 30, drawn to a polypeptide of SEQ ID NO:16, classified in Class 530, subclass 350.

XVI. Claims 33, 35-36, drawn to a cDNA encoding a polypeptide of SEQ ID NO:18, classified in Class 536, subclass 23.1.

XVII. Claim 34, drawn to a polypeptide of SEQ ID NO:18, classified in Class 530, subclass 350.

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XVIII. Claims 37, 39-40, drawn to a cDNA encoding a polypeptide of SEQ ID NO:20, classified in Class 536, subclass 23.1.

XIX. Claim 38, drawn to a polypeptide of SEQ ID NO:20, classified in Class 530, subclass 350.

XX. Claims 41, 43-44, drawn to a cDNA encoding a polypeptide of SEQ ID NO:22, classified in Class 536, subclass 23.1.

XXI. Claim 42, drawn to a polypeptide of SEQ ID NO:22, classified in Class 530, subclass 350.

XXII. Claims 45, 47-48, drawn to a cDNA encoding a polypeptide of SEQ ID NO:24, classified in Class 536, subclass 23.1.

XXIII. Claim 46, drawn to a polypeptide of SEQ ID NO:24, classified in Class 530, subclass 350.

XXIV. Claims 49, 51-52, drawn to a cDNA encoding a polypeptide of SEQ ID NO:26, classified in Class 536, subclass 23.1.

XXV. Claim 50, drawn to a polypeptide of SEQ ID NO:26, classified in Class 530, subclass 350.

XXVI. Claims 53, 55-56, drawn to a cDNA encoding a polypeptide of SEQ ID NO:28, classified in Class 536, subclass 23.1.

XXVII. Claim 54, drawn to a polypeptide of SEQ ID NO:28, classified in Class 530, subclass 350.

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XXVIII. Claims 57, 59-60, drawn to a cDNA encoding a polypeptide of SEQ ID NO:30, classified in Class 536, subclass 23.1.

XXIX. Claim 58, drawn to a polypeptide of SEQ ID NO:30, classified in Class 530, subclass 350.

XXX. Claims 61, 63-64, drawn to a cDNA encoding a polypeptide of SEQ ID NO:32, classified in Class 536, subclass 23.1.

XXXI. Claim 62, drawn to a polypeptide of SEQ ID NO:32, classified in Class 530, subclass 350.

XXXII. Claims 65, 67-68, drawn to a cDNA encoding a polypeptide of SEQ ID NO:34, classified in Class 536, subclass 23.1.

XXXIII. Claim 66, drawn to a polypeptide of SEQ ID NO:34, classified in Class 530, subclass 350.

XXXIV. Claims 69, 71-72, drawn to a cDNA encoding a polypeptide of SEQ ID NO:36, classified in Class 536, subclass 23.1.

XXXV. Claim 70, drawn to a polypeptide of SEQ ID NO:36, classified in Class 530, subclass 350.

XXXVI. Claims 73, 75-76, drawn to a cDNA encoding a polypeptide of SEQ ID NO:36, classified in Class 536, subclass 23.1.

XXXVII. Claim 74, drawn to a polypeptide of SEQ ID NO:36, classified in Class 530, subclass 350.

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The inventions are distinct, each from the other because of the following reasons:

Inventions I-XXXVII, are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which cannot be exchanged. The polynucleotide of invention I can be used to make a hybridization probe or can be used in gene therapy as well as in the production of the specific protein of interest of Group II. The protein of invention II can be used as a probe, or used therapeutically or diagnostically, e.g. in screening. The nucleic acid of invention I can only be used to obtain the protein of invention II, not any other protein. Similarly, the protein of invention IV, can be produced using the DNA of invention III, not by the DNA of invention I.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

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***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Prema Mertz*  
Prema Mertz Ph.D.  
Primary Examiner  
Art Unit 1646  
August 22, 2002